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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,899	01/27/2000	William R. Wells	3735-929	9213
27717	7590	01/11/2007	EXAMINER	
SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803			MAHMOUDI, HASSAN	
			ART UNIT	PAPER NUMBER
			2165	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/11/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/491,899	WELLS ET AL.
Examiner	Art Unit	
Tony Mahmoudi	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 October 2006.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5,6,8-10,12,13 and 24-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5,6,8-10,12,13 and 24-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Remarks*

1. In response to communications filed on 30-October-2006, claim 30 is cancelled, and claims 1, 5, 8, 12, and 27 are amended per applicant's request. Therefore, claims 1-3, 5-6, 8-10, 12-13, and 24-29 are presently pending in the application, of which, claims 1, 8 and 24 are presented in independent form.
2. Applicant's amendments made to claims 5, 12, and 27, overcomes the previous rejection made under the **2nd paragraph** of 35 U.S.C. 112. Accordingly, the rejection is withdrawn.
3. Applicant's arguments presented regarding the previous rejection of claims 1, 8, and 24 under 35 U.S.C. 101 have been reviewed and are deemed persuasive. Therefore, the rejection is hereby withdrawn.
4. Applicant's cancellation of claim 30 overcomes the objection made to this claim under Duplicate Claims. The objection is therefore withdrawn.

### *Priority*

5. The instant application claims benefit of the filing date to the U.S. Provisional Application S/N 60/153,745, filed on 13-September-1999. Accordingly, the filing date of the Provisional

Patent Application (13-September-1999) is considered the effective filing date for the examination of the instant application.

***Claim Objections***

6. Independent claims 1, 8, and 24 are objected to because of the following informalities:

Applicant's amendments to independent claims 1 and 8 has removed the phrase "**on the**" from the last limitation of the claims without the appropriate amendment markings (specifically, the claims used to read, "... and/or use a cash balance **on the** smart card to play the gaming apparatus" but now the claims read, "... and/or use a cash balance smart card to play the gaming apparatus".) Such removals have neither been enclosed in square brackets "[ ]" nor do they appear with strikethrough markings. Therefore, the removal of the phrase appears to the Examiner to be "accidental" or "typographical". The phrases "**on the**" need to be re-inserted in the claims, in order to prevent a new rejection under the second paragraph of 35 U.S.C. 112.

Independent claim 24 also has the missing "**on the**" phrase for the same limitation but the claim bears the status of "Previously presented". Therefore, the removal of the phrase appears to the Examiner to be "accidental" or "typographical". The phrases "**on the**" needs to be re-inserted in the claim, in order to prevent a new rejection under the second paragraph of 35 U.S.C. 112.

Appropriate corrections are required.

***Specification***

7. The specification amendment filed on 16-April-2004 *remains* objected to under 35 U.S.C. 132(a) because it introduces “new matter” into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“These cards may be of conventional dimensions, having a thickness less than about  $\frac{1}{4}$  inch, or less than 0.05 inch”, inserted in page 2 of the specification amendment filed on 16-April-2004, relating to the last complete paragraph of page 4 of the originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

The Examiner apologizes for not citing the “new matter” in the referenced amendment earlier, due to transfer of the instant application from another Examiner, and regrets any inconveniences caused by this unintentional oversight.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the *first paragraph* of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2, 9, 25 and 30 *remain* rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter,

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2 and 30 recite the limitation, “wherein said smart card has a thickness of less than about 0.05 inch”; claim 9 recites, “wherein said step of storing includes storing in a smart card having a thickness less than about 0.05 inches”; and claim 25 recites, “in which said card has a thickness of less than about one quarter inch”.

Nowhere throughout the originally filed specification, does any reference exist for the “thickness” of the card measured in inches or fraction of inches. In fact, this limitation was added to the specification in the amendment filed on 16-April-2004, and therefore constitutes “new matter”.

Again, the Examiner regrets any inconveniences caused by not citing this rejection earlier, as stated in paragraph 4 of this Office Action.

This rejection however can be overcome by amending the referenced claims to remove the reference made to the card thickness in inches, and by re-writing the claims’ limitation in a manner supported in the original specification (e.g., “wherein the smart card has a profile about the size of a typical credit card” for claims 2, 9 and 30, and, “wherein the smart card has a profile thicker than the size of a typical credit card” for claim 25.)

Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 6, 8, 12-13, 24, 26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orus et al (U.S. Publication No. 2004/0035926 A1, hereinafter referred to as Orus) in view of Soltesz et al (U.S. Publication No. 2001/0011680 A1, hereinafter referred to as Soltesz.)

As to claim 1, Orus teaches a gaming apparatus to be played by a player (see elements 200, 200' and 200" in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where "gaming apparatus" is read on "gambling machine", and "player" is read on "gambler"), comprising: a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card" is read on a "chip card"); storing financial account information for the player (see paragraphs 12, 14, 18, 46, 53, and 77-78, where "financial information" is read on "balance"); said biometric smart card carried by the player separate from the gaming apparatus (see paragraph 49, where "player" is read on "gambler", and the fact that the gambler "hands his gambling card to the operator" indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus);

a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24), configured for playing at least a first game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”);

a reader, coupled to the gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26) which receives data stored on said smart card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and a comparator for comparing data (see paragraphs 63 and 91) and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see “gambling operation is authorized” in paragraph 63.)

Orus does not teach:

a biometric smart card storing biometric data for the player;  
a reader which receives biometric data stored on said smart card;  
a biometric measurement device for measuring biometric data of a user to provide measured biometric data; and  
a comparator for comparing said measured biometric data to the biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account.

Soltesz teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches:

a biometric smart card storing biometric data for the player (see paragraphs 4, 13 and 19, where “smart card” is read on “optical/memory card”);

a reader which receives biometric data stored on said smart card (see element 2 in figure 1, and see paragraphs 28 and 30-31);

a biometric measurement device for measuring biometric data of a user (see element 3 in figure 1, and see paragraph 14, where biometric measurement device” is read on “biometric input/reader device”) to provide measured biometric data (see paragraphs 13 and 31-32); and

a comparator (see paragraph 29) for comparing said measured biometric data to the biometric data stored on said smart card (see paragraphs 14, 29, 31 and 38) and if there is a match, outputting an authorization allowing the player to access his or her account (see paragraph 14, where “accessing the account” is read on “authorizing a transaction”; and see paragraphs 29, 31, and 38.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus by the teachings of Soltesz, because “a biometric smart card storing biometric data for the player; the gaming machine to be coupled to a card reader for receiving the user’s biometric data stored on the smart card; a biometric reader to capture a user’s biometric data; and a comparator to allow the game to be played”, would provide both convenience and security for the player to use his smart card to play different games at different gaming machines (e.g., in a casino) using the same card and same account cash/token balance on the card. This enables the player to walk around in the casino cash-free without risking losing his cash or having to carry lots of coins around. Storing user’s biometric data (e.g., fingerprint) on the user’s card would prevent unauthorized use of the card should the card be stolen or lost and recovered by another player. When a player inserts a card into a gaming machine, he/she would also provide his/her biometric data (e.g.,

fingerprint) to the machine in real-time, which would then be compared with the biometric data stored on the card to verify that the game card is being used by the authorized user, therefore, preventing fraudulent transactions. In general, Soltesz solves the “prior art problems” of storing biometric information in databases and onsite, as opposed to storing them on portable devices such as smart cards, which he lists as follows: “The principal problem with the use of biometrics to verify cardholders in this context is the problem of communicating the biometrics information to the database, and communicating the results back to the site of the transaction. Storage of biometrics information on site is generally impractical, and is certainly inefficient when the card can be used with different kiosks, each of which would be required to store the necessary information. As a result, the use of biometrics information is limited to transaction devices which are networked or equipped to communicate with a remote database. This limits the range of applicability of biometrics verification to use in connection with existing networks and locations with appropriate infrastructure, thereby excluding much of the world, and also limits the speed at which transactions can be conducted (paragraph 9).” The combination of the gaming apparatus of Orus with the teachings of Soltesz would enable the gaming devices/terminals of Orus to function similar to the portable kiosks of Soltesz and provide the gaming convenience and security (as mentioned above) to game players.

As to claim 6, Orus as modified, teaches wherein:

    said biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a

facial scanner; or an infrared scanner (see “biometric reader device” in Soltesz, paragraphs 14 and 19; “image capture device” in paragraph 19; “biometric input device” in paragraphs 16, 21, and 28; and see “fingerprint reader” in paragraphs 31 and 44.)

As to claim 8, Orus teaches a gaming method (see paragraphs 2-3) for a gaming apparatus to be played by a player (see elements 200, 200' and 200" in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where “gaming apparatus” is read on “gambling machine”, and “player” is read on “gambler”), comprising:

storing first data for a player (see paragraphs 12, 14, 16) in a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card” is read on a “chip card”), which smart card is carried by the player separate from the gaming apparatus (see paragraph 49, where “player” is read on “gambler”, and the fact that the gambler “hands his gambling card to the operator” indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus), storing financial account information for the player in said smart card (see paragraphs 12, 14, 18, 46, 53, and 77-78, where “financial information” is read on “balance”), and also storing personal preference data for said player in said smart card (see paragraphs 12 and 18, where “personal preference data” is read on “card balance”; and read on “information on the gambler”);

providing a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24);

coupling a reader to said gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26), configured for playing at least a first

game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”), wherein said reader receives said first data stored on said smart card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and

comparing said data to said data stored on said smart card (see paragraphs 63 and 91); and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see paragraph 18; and see “gambling operation is authorized” in paragraph 63.)

**Orus** does not teach:

storing first biometric data for a player in a portable biometric smart card; measuring biometric data of said player to provide measured biometric data; and comparing said measured biometric data to said biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account.

**Soltesz** teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches the above.

For the above teachings, the applicant is directed to the remarks and discussions made in claim 1 above, in view of the teachings provided by **Soltesz**.

As to claim 12, **Orus** as modified, teaches wherein:

said smart card further stores the current account balance for an account established for said first user (see **Orus**, paragraphs 12, 46 and 53.)

As to claims 13 and 26, Orus as modified, teaches wherein:

said step of measuring includes a step selected from among: scanning a thumb print; scanning a fingerprint; scanning a retina; scanning an iris; scanning an ear; sensing voice data; or scanning a face (see “obtaining biometric data” in Soltesz, paragraphs 14 and 19; see “obtaining biometric data” from an “image capture device” in paragraph 19; and see “fingerprint reader” in paragraphs 31 and 44.)

As to claim 24, Orus teaches a gaming method (see paragraphs 2-3) for a gaming apparatus to be played by a player (see elements 200, 200' and 200" in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where “gaming apparatus” is read on “gambling machine”, and “player” is read on “gambler”), comprising:

storing first data for a player (see paragraphs 12, 14, 16) in a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card” is read on a “chip card”), which smart card is carried by the player separate from the gaming apparatus (see paragraph 49, where “player” is read on “gambler”, and the fact that the gambler “hands his gambling card to the operator” indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus) wherein said smart card also stores personal preference data for said player (see paragraphs 12 and 18, where “personal preference data” is read on “card balance”; and read on “information on the gambler”); providing a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24);

coupling a reader to said gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26), configured for playing at least a first game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”), and reading said data stored on said card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and

comparing said data to said data stored on said smart card (see paragraphs 63 and 91); and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see paragraph 18; and see “gambling operation is authorized” in paragraph 63);

reading from the same smart card a current account balance for an account established for said player (see paragraphs 27, 50 and 63); and

debiting an amount from said current account balance on said smart card as a fee for playing said game (see paragraphs 3, 14, 18 and 53), and establishing a new current account balance on said smart card (see paragraphs 27, 58, and 90.)

**Orus** does not teach:

storing first biometric data for a player in a portable biometric smart card; measuring biometric data of said player to provide measured biometric data; and comparing said measured biometric data to said biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account.

**Soltesz** teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches the above.

For the above teachings, the applicant is directed to the remarks and discussions made in claim 1 above, in view of the teachings provided by Soltesz.

As to claim 28, Orus as modified, teaches in which the player's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

As to claim 29, Orus as modified, teaches in which said smart card includes a microprocessor (see Orus, paragraphs 31, 33 and 68) and in which said smart card further stores a current account balance for an account established by said first user (see Orus, paragraphs 12, 46 and 53), in which the user's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

12. Claims 2-3, 5, 9-10, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orus in view of Soltesz, as applied to claims 1, 8 and 24 above, and further in view of Thompson (U.S. Patent No. 5,865,470.)

As to claims 2 and 9, Orus as modified, still does not *explicitly* teach wherein said smart card has a thickness of less than about 0.05 inch (Applicant is directed to paragraphs 4 and 6-7 of this Office Action, in view of the objection and rejections made to these claims regarding "new matter".)

Nonetheless, Thompson teaches a peel-off coupon redemption card with microprocessor chip [smart card] (see figures 38-39 and see column 12, lines 51-64), in which he teaches the smart card has a thickness of less than about 0.05 inch (see column 4, line 44 through column 5, line 3.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus as modified, by the teachings of Thompson, because using smart cards which have a thickness of less than about 0.05 inch, would enable the system's game cards to possibly also be used in other card readers (e.g., ATM machines or vending machines) to purchase snacks and/or obtain cash using the same gaming card on the premises, which would offer an additional convenience to the game player (at a casino, for example.) According to Thompson, “[c]onventional plastic credit cards are 0.021 to 0.027 inches in thickness. This is a standard thickness so that the plastic credit cards can be used in a machine that accepts plastic credit cards. All machines are designed to accept only this range of thicknesses for a plastic credit card” (column 4, lines 44-49.)

As to claims 3 and 10, Orus as modified, teaches wherein:

said smart card includes a microprocessor (see Orus, paragraphs 31, 33 and 68.)

As to claim 5, Orus as modified, teaches wherein:

said smart card further stores the current account balance for an account established for said first user (see Orus, paragraphs 12, 46 and 53.)

As to claim 27, Orus as modified, teaches in which the player's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orus in view of Soltesz, as applied to claims 1, 8 and 24 above, and further in view of Nakata et al (U.S. Patent No. 5,736,727, hereinafter referred to as Nakata.)

As to claim 25, Orus as modified, still does not *explicitly* teach wherein said smart card has a thickness of less than about one quarter inch (Applicant is directed to paragraphs 4 and 6-7 of this Office Action, in view of the objection and rejections made to these claims regarding "new matter".)

Nonetheless, Nakata teaches an IC communication card apparatus (see figure 1 and see column 2, lines 31-48), in which he teaches wherein said smart card has a thickness of less than about one quarter inch (see figures 7 and 8 and see column 4, lines 18-41, where "smart card" is read on "IC card" and "PC card", and where the "card thickness of about 5 mm (millimeters)" translates to a thickness of about one fifth of an inch, which is less than about one quarter of an inch.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus as modified, by the teaching of Nakata, because having a smart card with a thickness of about 5mm (or one quarter inch) would

enable the system to provide game players with a smart/IC card such as a PCMCIA card (or a customized smart card of the same thickness), which would not only provide additional security and/or functionality to the gaming machines/devices, but also due to the thickness of the card, misuse of the card would be prevented since the thickness of about one quarter inch is greater (thicker) than conventional/standard credit or debit cards, therefore, these cards cannot be used in ATM machines or in conventional credit/debit card authorization terminals, which would in turn, prevent fraudulent attempts by an unauthorized user, should the card be lost or stolen.

***Response to Arguments***

14. Applicant's arguments filed on 30-October-2006 with respect to the rejected claims in view of the cited references have been fully considered but they are not deemed persuasive:

In response to the Applicant's arguments regarding the specification containing "new matter", the arguments have been fully considered but are not deemed persuasive. The Examiner respectfully disagrees with the Applicant's arguments that the reference in some original claims about the "card thickness" remedies the "new matter" issues in the amended specification. The originally filed specification of the instant Application did not contain any teaching or references made to the "thickness of the card". The Examiner rejected the claims containing this limitation, under the first paragraph of 35 U.S.C. 112 (see Office Action mailed on 27-January-2004; pages 3 and 4.) The Applicant then amended the specification to include the "card thickness" limitation in his reply of 16-April-2004, which is considered

“new matter”. Hence, the Examiner maintains the objection made to the specification under 35 .S.C. 132(a) for containing “new matter.”

Applicant’s arguments regarding the rejection under the 1<sup>st</sup> paragraph of 35.U.S.C. 112, the arguments are fully considered but are not deemed persuasive in view of the “card thickness” limitation not taught in the originally filed specification of the instant Application (as detailed above). The Examiner maintains the rejections under 35 U.S.C. 112 (1<sup>st</sup> paragraph).

Applicant’s arguments regarding, “there is no teaching in Soltesz of the use of its system with gambling machines:, the arguments have been fully considered but are not deemed persuasive. While the reference’s “intended use” may be towards the self-service kiosk, there is no indication in the Soltesz reference that the system could not have any other “intended uses” such as, in this case, in gaming devices.

The Applicant further argues that the Soltesz’ invention “is used only for machines where an exact, expected service or product is provided to the user”, and that, “the player in the present invention does not control the outcome”. The Examiner respectfully disagrees with the Applicant. While the various games in a gaming center (casino) may be different, the outcome of the games being played by the player are considered exact, expected services. The player either loses the game, resulting in a deduction of funds from his account balance, or he wins the game, resulting in crediting his account balance. Furthermore, ***controlling the***

*outcome* of the process *by the player (as argued by the Applicant)* is not recited in the rejected claims of the instant Application. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the Applicant's arguments about the Examiner's motivation, that "the above" [Examiner's motivation] "is the invention of the applicant, and not the invention of Soltesz et al. or Orus et al.", the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Applicant argues that Orus teaches "a database that in parallel stores the data representing gambling operation carried out, particularly card identification data and data representing the balance of value units credited and/or debited...", and further states that, "this parallel storing of card identification data teaches away from the concept of Soltesz et al." The Examiner respectfully disagrees. What is important is that *all the claimed limitations* of the instant Application are taught by the combination of the references. If the combined references teach additional limitations beyond what the claims of the instant

Application require, that is no indication that the references cannot be combined to satisfy the claimed requirements proposed by the instant Application.

The Applicant further argues that, regarding claims 8 and 24 calling for the further step of "storing personal preference data for said player in said smart card". As detailed in the rejection of claims 8 and 24, the "personal preference data" of a user is taught by the primary reference (see paragraphs 12, 54 and 78, where "personal preference data" is read on "information on the gambler".) With regards to the Applicant's argument that the personal preference of the user as claimed in the instant Applications is different from what is taught by the references ("can be used for storing user preference information such as indication of types of games, drinks, entertainment and the like preferred, food, smoking/non-smoking preferences, preferred machine denominations and the like"), the Examiner maintains that "information on the gambler" taught by Orus can comprise all the recited preferences. Furthermore, again the specified preferences argued by the Applicant are not specifically recited in the rejected claims.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection (and/or objections) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

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November 14, 2006

*APN Mofiz Examiner  
Primary 2165  
TC*